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In re application of

Diehl et al.

Serial No. 10/612,288

Filed: July 3, 2003

For: HYDROTREATING CATALYST THAT CONTAINS A NITROGEN-CONTAINING
ORGANIC COMPOUND AND ITS USE

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DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY
OF THE OFFICE ACTION mailed September 27, 2005.

A petition was previously granted in this application to withdraw the finality of the office action
mailed March 18, 2005. An amendment was filed on July 18, 2005 in which all claims except
claims 18 and 19 were made dependent upon claim 21. Claim 21 was indicated as allowable by
the examiner in an advisory action mailed July 8, 2005. Claims 18 and 19 had previously been
indicated as allowable. On September 27, 2005, a final office action was mailed rejecting all of
the claims over newly cited prior art.

On October 11, 2005 the instant petition under 37 CFR 1.181 was filed to formally request the
withdrawal of finality of the September 27, 2005 office action.

Applicants position for the withdrawal of the finality is that the new grounds of rejection in the
final office action were not necessitated by Applicant's amendments to the claims.

DECISION

Section 706.07 of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final,
except where the examiner introduces a new ground of rejection that is neither
necessitated by applicant's amendment of the claims nor based on information submitted
in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)
with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that because all of the claims were previously indicated as allowable, the
amendments made did not necessitate the new grounds of rejection presented by the examiner in
the final office action. This argument is persuasive. The new grounds of rejection over all of the
claims were clearly not necessitated by Applicant's amendment because Applicants merely

followed the suggestions set forth by the examiner to present the allowable claims in the proper form. Because the scope of the claimed subject matter was not changed, there is no basis for the examiner's assertion that the amendments necessitated the new grounds of rejection. It is noted that on page 5 of the final office action the examiner states that the new grounds of rejection came about due to a new search and further consideration.

The finality was improper and the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. Applicant's time for response to the September 27, 2005 office action continues to run. Extensions of time may be obtained to file any amendments. Such amendments will be treated as an amendment under 37 CFR 1.111 or 1.112 and will be entered.



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